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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,650	01/16/2004	James E. Manuel	016295.1559 (DC-05989)	8070
23640	7590	09/26/2006	EXAMINER	
<b>BAKER BOTTS, LLP</b> 910 LOUISIANA HOUSTON, TX 77002-4995				PICKETT, JOHN G
ART UNIT		PAPER NUMBER		
3728				

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/759,650	MANUEL, JAMES E.
	Examiner Gregory Pickett	Art Unit 3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 05 July 2006.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-6,8-12,14 and 21-26 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-6,8-12,14 and 21-26 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 16 January 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

1. This Office Action acknowledges the applicant's amendment filed 5 July 2006. Claims 1-6, 8-12, 14, and 21-26 are pending in the application. Claims 7, 13, and 15-20 have been canceled. Claims 21-26 are new to the application.
  
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 102***

3. Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Keil (US 3,410,474; previously provided).

Claim 1: It is noted that the only structure recited in the claim is for a packing support having a top section and a bottom section with at least three detachable joints; all other limitations are intended use recitations. Accordingly, Keil discloses a packing support (Figure 2) with a top section **2 & 16** and a bottom section **18** with at least three detachable joints **12/14** operably detachable to cause the top section to separate from the bottom section (see Figure 2). Depending upon the unclaimed/undisclosed packing system, the joints of Keil are fully capable of maintaining the support intact while being packed and to allow the top section to be detached from the bottom section as claimed.

Claim 2: the joints of Keil are reusable.

Claim 3: Keil discloses a foam material (Col. 2, lines 34-39).

Claim 6: Keil discloses dovetail joints **12/14**.

4. Claims 21, 22, 25, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Bertelsen (WO 94/25369 A1; previously provided).

Claim 21: In accordance with MPEP 2111.01, during examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). Accordingly, when reading claim 21 broadly, it does not appear that all three (or more) joints are required to simultaneously engage each other upon connection of the upper and lower packing supports; they merely need to be capable of effecting the connection.

Given this broad interpretation, Bertelsen discloses a breakaway apparatus **1/101** for an information handling system **G** having eight corners; a first upper packing support **1** to receive first and second corners of system **G**; a first lower packing support **101** to receive third and fourth corners of system **G**; upper portions **7 & 8** of a first set of at least three detachable joints on upper packing support **1**; and lower portions **107 & 108** of a first set of detachable joints on upper packing support **101**, whereby the first set of detachable joints are operable to affix detachably and reuseably the first upper packing support to the first lower packing support.

Claim 22: Bertelsen anticipates a second upper packing support and second lower packing support to receive the fifth, sixth, seventh and eighth corners of system **G** (see Figure 3).

Claim 25: Bertelsen discloses four joints.

Claim 26: Bertelsen discloses upper and lower packing supports with c-shaped members (portions between projections **5** and **6** or **105** and **106**).

5. Claims 4 and 5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Keil (US 3,410,474; previously provided).

Claims 4 and 5 are product-by-process claims. Keil, as applied to claim 1 above discloses the claimed structures. The method of forming the device is not germane to the issue patentability of the device itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

#### ***Claim Rejections - 35 USC § 103***

6. Claims 8-12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prior Art Figure 1 of the instant application (hereinafter PA1) in view of Keil (US 3,410,474; previously provided).

Claims 8, 10, and 11: PA1 teaches the provision of a computer system **9** within a top-to-bottom support **4 & 6** and shipping container **2**. Applicant has admitted that the provision of a printed circuit board, processor, memory, and chassis within a computer system was common and conventional and that their provision within the computer system **9** of PA1 would have been obvious.

PA1 discloses the claimed invention except that PA1 uses a top-to-bottom support that completely surrounds the computer system instead of a corner-type support system that only receives a portion of the chassis. Keil shows that a corner-type support system that only receives a portion of the retained product was an equivalent structure known in the art. Therefore, because these two supports were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the corner-type supports of Keil for the top-to-bottom supports of PA1.

Keil discloses a detachable container support (Figure 2) designed to receive a fragile item and having a first section **2 & 16**, a second section **18**, and detachable joints **12/14**. Joints **12/14** are dovetail joints and are capable of maintaining their connection while being packed. Further, the support is made of a resiliently deformable foam material (Col. 2, lines 34-39). It is noted that the disclosure of the applicant allows that resilient deformation of the dovetail joint for separation of the top and bottom section is a suitable arrangement (page 18, lines 21-24 of the instant application). As such, resilient deformation is considered "operably designed". Since the assembly of Keil is made of resiliently deformable foam, the joints **12/14** will deform and release their connection. As such, the system of Keil is considered "operably designed" to be detached from the bottom section while the product and bottom sections are still retained in the outer shipping container.

Claim 9: the joint of Keil is reusable.

Claims 12 and 14 are product-by-process claims. PA1-Keil, as applied to claim 8 above, discloses the claimed product. The method of forming the device is not germane to the issue patentability of the device itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bertelsen (WO 94/25369 A1; previously provided).

Bertelsen discloses the claimed invention except for the foam material. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the assembly from a foam material in order to reduce any particulate debris that may accompany the specified pulp material. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

8. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bertelsen as applied to claim 22 above, and further in view of Hauss (US 3,511,990; previously provided).

Bertelsen discloses the claimed invention except that Bertelsen uses a pin and socket joint instead of a dovetail joint. Hauss shows that a dovetail joint was an equivalent structure known in the art (see Figures 2 & 3). Therefore, because these two

joining means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute a dovetail joint for a pin and socket joint. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

***Response to Arguments***

9. Applicant's arguments filed 5 July 2006 have been fully considered but they are not persuasive.

10. In response to the applicant's arguments against the Keil reference, it is noted that either portion 2 or 16 may be considered a top section and all three joints are operable for the separation of the components.

11. As to the combination of PA1 and Keil, applicant's own specification acknowledges the equivalences of corner protection and the top/bottom panels of PA1 (see specification at page 3, line 20 to page 4, line 9). In order to rely on equivalence as a rationale supporting an obviousness-type rejection, the equivalency must be recognized in the prior art. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958). Applicant's admission in the Background section of the instant application represents evidence that corner pieces and top/bottom panels were art-recognized equivalent structures for shock-protective packaging. An express suggestion to substitute one

equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*GP*  
Greg Pickett  
Examiner  
16 September 2006

*my*  
Mickey Yu  
Supervisory Patent Examiner  
Group 3700